

CPO. Sellers who can provide a product or service within the parameters of the CPO can bind the buyer to the sale. In one embodiment, sellers unwilling to accept the buyer's terms (e.g., the price is too low) can counteroffer.

The Examiner stated that claims 4, 5, 7 and 8 are obvious over Walker in view of Official Notice taken by the Examiner. The Examiner stated that Walker discloses all the limitations of claims 4, 5, 7 and 8, except for the application of the process to intellectual property assets. Applicant disagrees.

First, Walker does not teach or suggest all the elements of claims 4, 5, 7, and 8. For instance, Walker does not disclose placing a property up for auction and receiving a bid which includes an interest in another intellectual property asset, as described by Applicant and claimed in claim 4. The cite in the Office Action (col. 30, lines 30-40) describes a transaction that is different than that claimed by Applicant in claim 4. At col. 30, lines 36-39, Walker recites:

“A first party who wanted to get rid of a motorcycle, for example, could post CPO 100 in which he offered to exchange the motorcycle for a first class ticket from New York to London.”

For instance, claim 4 includes “designating a proposed transfer of a first intellectual property asset” and “gathering bids . . . wherein at least some of the bids define a transfer of an interest in a second intellectual property asset...” In contrast to Walker, where the person initiating the transaction lists the non-monetary items he or she wishes to trade (e.g, a motorcycle for an airline ticket), in the method claimed in claim 4, the party bidding on the first intellectual property asset can offer as a bid a second intellectual property asset. It is not necessary for the first party to even be aware of the existence of the second intellectual property asset. That method is claimed in claim 4 through the use of the phrase “wherein at least some of the bids define a transfer of an interest in a second intellectual property asset “ (emphasis added).

Likewise, Walker does not disclose limiting bidding to bidders meeting an access profile, or limiting bidding to bidders who do not meet an access profile. Both approaches are described by Applicant, and claimed in amended claims 5 and 8. Further, Walker does not disclose pooling assets for sale as a package as described by Applicant and claimed in amended claim 7. Thus, Walker does not teach each element of claims 4, 5, 7, and 8.

Claims 2, 9 and 10 were rejected under 35 USC § 103(a) as being unpatentable over Fisher et al. (U.S. 5,835,896) in view of Official Notice taken by the Examiner.

With regard to claim 2, the Examiner stated that Fisher discloses all the limitations of claim 2, except for the application of the process to intellectual property assets and automatically donating intellectual property assets to a charitable organization in the event no sufficient bids are gathered.

Applicant respectfully submits that the Office Action does not make out a *prima facie* case of obviousness for at least two reasons. First, Fisher does not teach each and every element of Applicant's claims. Second, Fisher teaches away from Applicant's claims. For these reasons, the Office Action has not made out a case of *prima facie* obviousness.

First, in order to make out a *prima facie* case of obviousness Fisher must teach or suggest all the claim element. For instance, Applicant teaches, and claims in claim 2, "automatically donating the intellectual property asset to a charitable organization in the event no sufficient bids are gathered within a period of time." Fisher does not describe an auctioning method which culminates in a donation to charity. In contrast, Fisher describes items remaining on sale until the available quantity is purchased and adjusting the price based on sales volume to keep the price of merchandise as high as possible. Fisher, col. 11, lines 44-64. Thus, Fisher does not teach or suggest automatically donating the intellectual property asset as recited in claim 2.

Second, contrary to the Examiner's statement, there is no teaching or suggestion to modify Fisher to include donating the asset to charity at the end of the auction. A factor cutting against a finding to modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. For example, claim 2 recites, "automatically donating the intellectual property asset to a charitable organization in the event no sufficient bids are gathered within a period of time." In contrast, Fisher recites, "The item remains for sale until the available quantity is purchased." Col. 11, lines 47-48. In further contrast, Fisher recites:

"[I]f a certain sales volume is exceeded in a specified period of time, the electronic auction system automatically increases the price by a set amount or by a

set percentage of the price and updates the merchandise page accordingly. These automatic price changes allow the seller to respond quickly to market conditions while keeping the price of the merchandise as high as possible to the sellers benefit" Col. 11, lines 57-64.

Thus, Fisher teaches away from claim 2 because the object of Fisher is to maximize the seller's benefit only through selling all merchandise at a high price. Claim 2 provides a mechanism for deriving tax benefits from the donation of intellectual property assets to a charitable organization. Thus, because the object of Fisher is to maximize the seller's benefit only through high prices, Fisher teaches away from Claim 2.

The original claim 9 included the limitations of offering options to purchase an interest in an intellectual property asset and accepting requests from network users to purchase the option. Those limitations remain in the claim as amended. Applicant is unable to locate where Fisher describes offering and accepting requests to purchase options to purchase an asset such as intellectual property. Thus, the Office Action has not made out a *prima facie* case of obviousness as to amended claim 9.

Finally, claim 10 has been amended to include limitations such as associating an access profile with a bidders. Fisher does not describe gathering bids as a function of an access profile.

Applicant respectfully submits that Fisher is nonobvious over claim 2 and amended claims 9 and 10 because Fisher does not disclose all the elements of claim 2 and amended claims 9 and 10.

Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejections and reconsideration and allowance of claims 2, 4-5, and 7-10.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6902) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 5th day of December, 2002.

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